REMARKS

Applicants hereby amend claims 1-2, 6, 8-9, 11-14, 18, 20, 25-26, and 29-35;

cancels claims 3-4, 15-16, and 27-28 without disclaimer of the subject matter therein;

and adds new claims 36-41.[1] No new matter is included in these amendments. Claims

1-2, 5-14, 17-26, and 29-41 are pending in the application, with claims 1, 13, and 25

being in independent form.

In an Office Action[2] the Examiner took the following actions:

(a) rejected claims 1-35 under 35 U.S.C. § 101 as allegedly being
directed to non-statutory subject matter;

(b) objected to claims 5-11, 17-23, and 31-34 under M.P.E.P. 35
§ 608.01(n);

(c) objected to claim 12 under 37 C.F.R. 1.75(c); and

(d) rejected claims 1-35 under 35 U.S.C. § 102 as allegedly being
anticipated by U.S. Patent No. 7,016,936 to Wilkinson et al.
("*Wilkinson*")

(a) § 101 Rejection of claims 1-35

In the Office Action, claims 1-35 were rejected under 35 U.S.C. § 101 as

allegedly being directed to non-statutory subject matter. Although Applicants maintain

that the claims as filed fall squarely within the scope of section 101, Applicants have

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[1] Claims were amended solely to expedite prosecution. Applicants preserve the right to
pursue the original subject matter in subsequent applications.
[2] The Office Action may contain a number of statements reflecting characterizations of
the related art and the claims. Regardless of whether any such statement is identified
herein, Applicants decline to automatically subscribe to any statement or
characterization in the Office Action.

amended the independent claims and claims depending from claim 25 in order to conform to current U.S.P.T.O. practice and to advance prosecution.

The Office Action alleged that "the claims are not sufficiently tied to an apparatus, such as a computer, and/or do not transform the underlying subject matter (from your claim) to a different state" and further alleged that "the claims recite a method, computer program stored on a medium and a system for defining and storing prioritized experiences without creating a tangible result." Office Action, p. 2-3. The Office Action cited *In re Comiskey* for the proposition that "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Id.* (citing *In re Comiskey*, 499 F.3d 1365, 1380 (Fed. Cir. 2007)). Applicants respectfully disagree with this characterization of Applicants' claims and this interpretation of *In re Comiskey*. In *Comiskey*, after making the above statement cited by the Examiner, the Federal Circuit found that claims that "combin[ed] the use of machines with a mental process, claim patentable subject matter." *See In re Comiskey*, 499 F.3d at 1379-80. According to the Federal Circuit, a method is patentable if it is "tied to a particular apparatus or . . . operated to change materials to a 'different state or thing.'" *In re Comiskey*, 499 F.3d at 1376.

Claim 1, as amended, is tied to particular devices, such as a plurality of different types of communication channels and a central, channel-independent processing engine. Independent claims 13 and 25 recite a computer program stored on a computer readable medium and a computer-implemented system for optimizing customer experiences, respectively. Therefore, claims 13 and 25 recite statutory subject matter. Furthermore, since the three independent claims recite statutory subject matter, the

claims depending therefrom incorporate these recitations and therefore also recite statutory subject matter. Applicants have cancelled claims 3-4, 15-16, and 27-28, thereby rendering the rejection of these claims moot, however, new claims 36-41 have been added that generally correspond to cancelled claims 3-4, 15-16, and 27-28.

In view of the above-discussed amendments, Applicants respectfully request that the 35 U.S.C. § 101 rejection be withdrawn.

(b) Objection to claims 5-11, 17-23, and 31-34

In the Office Action, claims 5-11, 17-23, and 31-34 were objected to because "a claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim." Office Action at 3-4. Claims 2-3, 15-16, and 17-28 have been cancelled and claims reciting similar subject matter have been added as new claims 36-41. Applicants respectfully request that, when this Application is allowed, the Examiner renumber new claims 36-37 to follow application claim 12, new claims 38-39 to follow application claim 24, and new claims 40-41 to follow application claim 35 pursuant to M.P.E.P. 608.01(j), which would prevent "a dependent claim . . . [from being] separated by any claim which does not also depend from said dependent claim." Applicants therefore request that the Examiner withdraw the objection to claims 5-11, 17-23, and 31-34.

(c) Objection to claim 12

In the Office Action, claim 12 was objected to as being "of improper dependent form for failing to further limit the subject matter of a previous claim" and because "claim 12 is a method dependent from subsequent claim 21." Applicants have amended claim 12 to correct a typographical error and depend from claim 2. In view of Applicants'

amendment, Applicants respectfully request that the Examiner withdraw his objection to claim 12.

(d) Rejection of claims 1-35 under 35 U.S.C. § 102

Claims 3-4, 15-16, and 27-28 have been cancelled, thereby rendering the rejection of these claims moot. New claims 36-41 have been added, and correspond generally to cancelled claims 2-3, 15-16, and 27-28. Claims 1-2, 4-14, 17-26, and 29-35 have been rejected as being anticipated by *Wilkinson*. Based on the foregoing amendments and the arguments set forth during the October 16, 2008 Interview, Applicants respectfully traverse this rejection.

In order to establish anticipation under 35 U.S.C. § 102, the Examiner must show that each and every element as set forth in the claim is found, either expressly or inherently, in *Wilkinson*. *See* M.P.E.P. § 2131. *Wilkinson*, however, does not disclose each and every element of Applicants' claims.

First, regarding amended claim 1, *Wilkinson* does not disclose or suggest Applicants' claimed method, including, for example, the step of "storing the plurality of prioritized experiences in a central repository that is configured such that the stored plurality of prioritized experiences is available for application across a plurality of different types of communication channels by a central, channel-indepenedent processing engine."

The Office Action cited *Wilkinson* as teaching "storing the plurality of prioritized experiences for consistent treatment among a plurality of channels", citing Figure 1,

item 15.[3] Office Action at 5. The Office Action also cited *Wilkinson* as teaching

"wherein the step of storing is done to a central repository where the stored experiences

are available across a plurality of types of communication channels," citing column 10,

lines 41-48 and Figure 1, item 15. Office Action at 5. However, the cited portion of the

Wilkinson text only discloses that

> In one embodiment of the present invention, database 110
> includes a real time response component 115 and a
> historical data component 117. Real time response
> component 115 forwards data relevant to an interaction
> motivation plan (e.g., offers and responses) and other
> relevant customer behavior data to the Testing Module 130.
> Testing module 130 utilizes the information to refine the
> Customer Behavior Model and to create new Offer Plans.

Wilkinson at col. 10, ll. 41-48. Neither this portion nor any part of the reference teaches

the limitation recited above as required by claim 1.

Although *Wilkinson* does generally disclose that "[e]lectronic systems (e.g., the

Internet) usually support a variety of information communication configurations such as

information communication from a central resource (e.g., a central location such as a

web site hosted on a server computer) to remote resources (e.g., a personal computer

at a remote location such as a home or business)" (*Wilkinson*, col. 1, ll. 46-52, emphasis

added; see also Fig. 2B), when discussing the "database module 110" that includes

"real time response component 115," *Wilkinson* states

> **Database module 110 receives and stores** information
> associated with target interaction (e.g., information about
> customers such as descriptive and behavioral characteristics
> and their interactions with real time electronic service

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[3] Applicants note that Fig. 1 of *Wilkinson* does not include an item number 15.
Applicants believe the Examiner intended to cite item 115 of Fig. 1 and have
responded accordingly.

interaction management system 100), relevant system state and external state information, as well as **information associated with the state of a touch-point (a point of interaction with the system).**

Wilkinson at col. 7, ll. 39-46 (emphasis added). Wilkinson defines a "touch point" as one of "a website, call center, email, phone system, a graphical user interface etc." Wilkinson at col. 7, l. 67 - col. 8, l. 2. Therefore, *Wilkinson* teaches that database module 110 stores information associated with **a** touch-point, which is different from ". . . [a] stored plurality of prioritized experiences . . . available for simultaneous application across *a plurality of different types of communication channels* by a *central, channel-indepenedent processing engine"* as recited in Applicants' claim 1. *See e.g.*, Applicants' Figure 5. Wilkinson does <u>not</u> disclose using a centralized, channel-independent engine to drive interactions with a plurality of different types of touch points (or their corresponding communication channels) at the same time.

Because *Wilkinson* does not disclose each and every element of amended independent claim 1, *Wilkinson* does not anticipate claim 1 under 35 U.S.C. § 102(e). Therefore, amended claim 1 should be allowable over *Wilkinson*. Although different in scope from claim 1 and from each other, amended independent claims 13 and 25 include similar recitations to those discussed above with respect to amended claim 1. Claims 2, 5-12, and 36-37 depend directly or indirectly from claim 1; claims 14, 17-24, and 38-39 depend directly or indirectly from claim 13, and claims 26, 29-35, and 40-41 depend directly or indirectly from claim 25. Accordingly, claims 1, 13, and 25, and their dependent claims 2, 5-12, 14, 17-24, 26, and 29-41 are not anticipated by and should be allowable over *Wilkinson*. Applicants therefore respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection over *Wilkinson*.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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